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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/674,097	09/26/2003	Timothy J. Olah	KAN144/104044	2164

24030 7590 06/21/2006

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EXAMINER
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SLACK, NAKO N

ART UNIT	PAPER NUMBER
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3635

DATE MAILED: 06/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/674,097	Applicant(s) OLAH, TIMOTHY J.	
	Examiner Naoko Slack	Art Unit 3635	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 November 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>11/3/03</u> | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Objection***

Claim 13 is objected to because of the following informalities: In claim 13, line 8, "tor" should probably be - - to - -. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-12, 20, 21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is drawn to "structural members" (line 3), "frame side members" (lines 3-4), and frame end members (line 4); however, in line 5, it is unclear which members are being referenced in the statement "each of said members having a planar side surface". Clarification and correction are required.

The preamble of claim 1 indicates that claim 1 is drawn to the subcombination of a "panel assembly." The phrase "for connection with... girders" is a statement of intended use and does not positively recite of the combination of the panel assembly with the girders. However, claims 3 and 4, which depend from claim 1, positively recite the combination of the panel frame assembly with a girder, stating that a bracket member connects an end of the panel frame with a girder. It is unclear if applicant

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intended the combination of the panel assembly with the girder or the subcombination of the panel assembly alone. Clarification and correction is required.

For purposes of examination, it is assumed that applicant intended to claims the subcombination of the panel assembly.

Similarly, the preamble of claim 20 is drawn to a "panel system" but positively recites the combination of the panel frame assembly with a girder, stating "said panels being joined to said girders" (line 14). Clarification and correction is required.

For purposes of examination, it is assumed that applicant intended the combination of the panel assembly with the girder.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 5-7, 9-17, 19-26 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by US Patent 4,603,532 to Watson.

Claims 1 and 13:

Watson discloses a modular panel assembly comprising structural members (Figure 1) including frame side members and frame end members, each side and end member having planar side surfaces, the side and end members being joined at their

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ends to form a rectangular panel frame, and a deck member secured to a top side of the frame.

Claims 2 and 15:

Watson discloses fasteners (22) enabling attachment of the frame ends members to girders (Figure 4).

Claims 5 and 16:

Watson's frame end members are capable of connection with girders (18, Figure 4), and the frame side members are capable of connection with frame side members of additional panel assemblies (3, Figure 4).

Claim 6:

Watson's frame end members are capable of connection to girders, and the frame end members are capable of connection with frame end members of additional panel assemblies (Figure 5).

Claims 7 and 17:

Watson's frame members have a generally C-shaped cross section (8, Figure 4 and 7, Figure 5).

Claims 9-11, 14:

Watson's panels are joined in side-by-side relation and end-to-end relation (3, Figure 3).

Claims 12 and 19:

Watson's frame of girders (18) is connected with the panel side members in spanning relationship (Figures 4 and 5). The phrase "for supporting a roof top unit" is a

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recitation of intended use, which does not further limit the structural features of the claimed invention. It has been held that a recitation regarding the manner in which a claimed apparatus is intended to be used does not differentiate the claimed apparatus from a prior art apparatus which satisfies the claimed structural limitations (Ex Parte Masham, 2 USPQ F2nd 1647, 1987).

Claim 20:

Watson discloses a panel system comprising a plurality of rectangular panel frames, each frame including structural panel frames including frame side members and frame end members, each side and end member having planar side surfaces, the side and end members being joined at their ends to form a rectangular panel frame, and a deck member secured to a top side of the frame. The panels are joined to girders (18), the panels being joined in side-by-side relation by connection of side members (Figure 5).

Claim 21:

The frame structural members have C-shaped cross section (7 and 8), and the structural members are oriented to enable webs of the structural members to form the outer perimeter surface of the frames.

Claims 22-26:

Watson discloses a method of assembling a panel system comprising a plurality of rectangular panel frames, each frame including structural panel frames including frame side members and frame end members, each side and end member having planar side surfaces, the side and end members being joined at their ends to form a

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rectangular panel frame, and a deck member secured to a top side of the frame. The panels are positioned atop girders and connected to girders (18) with fasteners (22). The coupling of end members must be performed from a position below the panel assembly, as the deck members (3) render the attachment apertures inaccessible from above the panel.

Claims 1 and 3 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by US Patent 3,447,771 to Trimmer.

Claim 1:

Trimmer discloses a modular panel assembly comprising structural members (10, Figure 1) including frame side members and frame end members, each side and end member having planar side surfaces, the side and end members being joined at their ends to form a rectangular panel frame, and a deck member secured to a top side of the frame.

Claim 3:

Trimmer discloses a bracket member (30, Figure 30) capable of attaching the panel frame to a girder.

Claims 1, 8, and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent 5,160,640 to Babstieber.

Claim 1:

Babstieber discloses a modular panel assembly comprising structural members (1, Figure 1) including frame side members and frame end members (2), each side and end member having planar side surfaces, the side and end members being joined at their ends to form a rectangular panel frame, and a deck member secured to a top side of the frame.

Claims 8 and 18:

Babstieber discloses at least one of the structural members has a tubular cross-section (top tubular members, Figure 2).

#### ***Allowable Subject Matter***

Claim 4 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

#### ***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Naoko Slack whose current telephone number is 571-272-6848. The examiner can normally be reached on Mon-Fri (6:00 am-2:30pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl D. Friedman can be reached on 571-272-6842. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Naoko Slack  
Primary Examiner  
Art Unit 3635

NS

June 16, 2006